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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/710,368	11/10/2000	Michael Dean Whitmarsh	10003975-1	5508

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EXAMINER

PHAM, THIERRY L

ART UNIT PAPER NUMBER

2624

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/710,368	Applicant(s) WHITMARSH ET AL.	
	Examiner Thierry L. Pham	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,9-11,13-20 and 23-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,9-11,13-20 and 23-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- This action is responsive to the following communication: an Amendment filed on 9/19/05.
- Claims 1-6, 9-11, 13-20, 23-25 are pending; claims 7-8, 12, 21-22, and 26 have been canceled.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 9-11, 13-20, 23-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Blumberg et al (U.S. 2003/0140315).

Regarding claim 1, Blumberg discloses a method of processing an image (*on-demand print server processes the image before sending to the print provider, pars. 9-15, page 1*) before printing of the image by a print provider, the method comprising the steps of:

- (●) defining a print processing system controller (*on-demand print server, fig. 3*) having a network communication link (*Internet network, fig. 3*);
- (●) receiving at the print processing system controller a print request (*print order requests with finishing options, fig. 6, pars. 9-15, page 1 and pars. 28-34, page 2*) and a data file (*electronic documents, pars. 16-17, 28-29, and 66*) for the image via the network communication link, the print request identifying one of a specified application (*e.g. business cards, envelopes, personalized documents, etc., par. 28 and par. 40*) and a specified printing option including at least one of a print medium size and a printing medium type (*finishing options including paper size and type, par. 28 and pars. 65-71*) for the image; and
- (●) determining an appropriate application (*determining and applying appropriate applications for received document and inputted finishing options, par. 191, 195-198, and pars. 223-226*) for the image with the print processing system controller based, in part, on the image, including

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processing the print request and the data file for the image (*i.e. the server determines which applications such as print media, color and etc that is appropriate for the image, pars. 142-147*) by the print processing system controller (*on-demand print server receives a print order (images/documents printing) with finishing options selected by the users/customers and then on-demand print server determines received document data and its finishing options are appropriate and to apply an appropriate application, par. 196-198 and par. 223-226*) to detect an image characteristic including at least one of a print resolution (*resolution, par. 174*), a bit depth, a size, a file size (*image size and format, par. 174*), and a quality of the image (*image quality, par. 138*) and detect the one of the specified application and the specified printing option for the image (*an example as shown in pars. 223-226*), and including comparing (*print server displaying a view of a virtual representation of a document (i.e. business card) based upon a specified application (i.e. business card), selected printing options, and image quality for comparing purposes, par. 145 and pars. 223-226*) the image characteristic and the one of the specified application and the specified printing option to determine the appropriate application (*pars. 196-198 and 223-226*) for the image.

Regarding claim 2, Blumberg further discloses the method of claim 1, wherein the network communication link includes an Internet communication link (Internet communication network, fig. 3).

Regarding claim 3, Blumberg further discloses the method of claim 1, further comprising: defining the network communication link between a customer and the print processing system controller, and wherein receiving the print request and the data file for the image includes receiving the print request and the data file (image data with selected parameters, pars. 28-34, page 2) for the image from the customer via the network communication link.

Regarding claim 4, Blumberg further discloses the method of claim 1, further comprising: defining the network communication link between a customer and the print processing system controller (fig. 3, pars. 148-154, page 7); and reporting the appropriate application (par. 196-198 and par. 223-226) for the image to the customer via the network communication link.

Regarding claim 5, Blumberg further discloses the method of claim 1, further comprising: defining the network communication link between the print provider and the print processing system controller (fig. 3), and wherein the step of receiving the print request and the data file for the image includes receiving the print request and the data file for the image from the print provider via the network communication link.

Regarding claim 6, Blumberg further discloses the method of claim 1, further comprising: defining the network communication link between the print processing system controller (communication network, fig. 3) and at least one of a content provider (print provider, par. 34, pages 2-3) offering a plurality of images (pre-defined templates, pars. 28-44, pages 2-3) and an application provider offering an application for the image, and wherein the step of receiving the print request and the data file for the image includes receiving the print request and the data file for the image from the at least one of the content provider (pars. 28-44, pages 2-3) and the application provider via the network communication link.

Regarding claim 9, Blumberg further discloses the method of claim 1, wherein receiving the print request and the data file for the image includes receiving a request for a plurality of appropriate applications (par. 196-198 and par. 223-226) for the image.

Regarding claim 10, Blumberg further discloses the method of claim 1, wherein determining the appropriate application for the image includes determining an appropriate print medium size for the image (par. 196-198 and par. 223-226).

Regarding claim 11, Blumberg further discloses the method of claim 1, wherein determining the appropriate application for the image includes determining an appropriate quality (i.e. colors finishing options, pars. 28-34, page 2) for the image.

Regarding claim 13, Blumberg further discloses the method of claim 1, wherein receiving the print request and the data file for the image includes specifying at least one of a print medium size and a print medium type for the image (media type and size, pars. 28-34, page 2), and wherein the step of determining the appropriate application for the image further includes determining whether the at least one of the print medium size and the print medium type (media type and size, pars. 28-34, page 2) is appropriate for the image.

Regarding claims 14-20, 23-25 recite limitations that are similar and in the same scope of invention as to those in claims 1-6, 9-11, and 13 above; therefore, claims 14-20, 23-25 are rejected for the same rejection rationale/basis as described in claims 1-6, 9-11, and 13.

Response to Arguments

- Applicant's arguments, see page 7, filed 9/19/05, with respect to claim objections (claims 1 & 14) have been fully considered and are persuasive. The objection of claims 1 & 14 has been withdrawn.
- Applicant's arguments, see 7, filed 9/19/05, with respect to 112th, 2nd paragraph rejection (claims 1 & 14) have been fully considered and are persuasive. The 112th, 2nd paragraph rejection of claims 1 & 14 has been withdrawn.
- Applicant's arguments filed 9/19/05 have been fully considered (with respect to prior art rejection) but they are not persuasive.

Regarding claims 1 & 14, the applicants argued the cited prior art of record (US 2003/0140315 to Blumberg et al) does not detect an image characteristics including at least one of a print resolution, a bit depth, a size, a file size, and a quality of an image, and compare the image characteristics and one of a specified application and a specified printing option of the image to determine an appropriate application for the image. Furthermore, the applicants also argued the service of Blumberg et al does not determine whether the finishing options selected by the user are appropriate for the document.

In response, the examiner fully disagrees with the applicants' assertions/arguments. Blumberg clearly teaches a system for detecting an image characteristics including at least one of a print

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resolution, a bit depth, a size, a file size, and a quality of an image, and comparing the image characteristics and one of a specified application and a specified printing option of the image to determine an appropriate application for the image *(on-demand print server receives a print order (images/documents printing) with finishing options selected by the users/customers and then on-demand print server determines received document data and its finishing options are appropriate and to apply an appropriate application, par. 196-198 and par. 223-226)*.

For example, paragraphs 223-226 of Blumberg clearly teaches a "Virtual Builder can incorporate rules regarding the design of finished documents. For example, such a rule might be that "you cannot use a glue binding with heavy weight paper." Virtual Builder can preclude such a design by disabling glue binding in the binding selection list if a heavy weight paper is already selected, or vice versa. Alternatively, if a user selects both a heavy weight paper and a glue binding, Virtual Builder can pop up a message box with an error message, similar to the way Microsoft Excel pops up a message box if a user introduces a circular reference into a spreadsheet.

[0224] Similarly, Virtual Builder can also include tips. For example, such a tip might be that "you should not use a glue binding with heavy weight paper, as it might fall apart." If a user selects both a heavy weight paper and a glue binding, Virtual Builder can pop up a message box with a tip. In this way, Virtual Builder acts as a guide for the user to create a finished document that is well designed.

[0225] Tips can also be price conscious. For example, such a tip might be that "if you can cut out two pages of your booklet, the cost of the job will go down by 25%, since it will require much less paper stock." In this way, Virtual Builder can incorporate the educated and experienced advice a customer normally gets from print salesmen.

[0226] Similarly, along with rules and tips, Virtual Builder can include a capability to control allowable product sets. Allowable product sets can be used to restrict a user from applying various finishing options or combinations of finishing options. For example, a corporation can restrict its users from printing documents in color. It may also restrict its users from applying finishing options that are priced higher than corresponding prices of alternative print service providers."

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

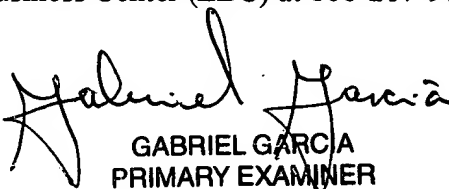
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham



GABRIEL GARCIA
PRIMARY EXAMINER